

### REMARKS

This responds to the Office Action mailed on November 17, 2003.

Claims 10-22 were cancelled without prejudice to prosecute them at Applicant's option in a Divisional or Continuation application. Claims 1-9 and 23-28 are now pending in this application.

#### §102 Rejection of the Claims

Claims 1-3 and 5 were rejected under 35 USC § 102(b) as being anticipated by Zink et al. (U.S. 5,963,045). Applicant respectfully traverses this rejection and requests the Office to consider the following.

To anticipate a claim, the reference must teach every element of the claim. M.P.E.P. § 2131.

It is well settled that "[a] claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil of California, 814 F.2d 628, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) "The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co. 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Further, "the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public." In re Brown, 141 USPQ 245, 249 (CCPA 1964). In particular, Brown repeats old law (1890) that

the description must place the invention in the possession of the public as fully as if the art or instrument itself had been practically and publicly employed. In order to accomplish this it must be so particular and definite that from it alone, without experiment or the exertion of his own inventive skill, any person versed in the art to which it appertains could construct and use it.

Id. at 249. In the present case Zink's test unit 166 cannot "place the claimed embodiments in possession of the public as fully as if the art or instrument itself had been practically and publicly employed". Applicant respectfully asserts that to construe a "test unit 166 10" as taught by "Zink is repugnant to ordinary and plain usage of the term "board". Within the scope of the

disclosure, which is Applicant's claimed scope, Zink fails to enable or anticipate the rejected claims.

Zink does not teach the limitation in claim 1 of an "extension board". The structure in Zink is a test fixture 166 (FIG. 11) that does not couple to the circuit board 145, rather, it is "brought into alignment so that test probes 154-160 will engage conductive pads 146-152. Zink's test fixture 166 is not a board. Consequently, claims 1-5 are not anticipated by Zink. That Zink's test fixture 166 may have certain dimensions of "thin and flat" (Office Action at page 2), is immaterial to the scope of what is claimed. Withdrawal of the rejections is respectfully requested.

Claims 1-9 and 23-28 were also rejected under 35 USC § 102(b) as being anticipated by Korsunsky et al. (U.S. 5,383,095). Applicant respectfully traverses this rejection and requests the Office to consider the following.

Korsunsky does not teach the limitations in independent claims 1, 6, 23, and 26 of an "extension board". The structure in Korsunsky is an electrical connector 10 that cannot be construed to be a board. The Office Action states this assertion is not supported. (Office Action at page 3). Applicant respectfully insists that a "board" is not an appropriate appellation for the "edge-mounted electrical connector 10" taught by Korsunsky. Were it appropriate, Korsunsky would call it a "board 10" similar to his appellation for his "circuit board 12". The structure 10 of Korsunsky is a multi-dimensional, multi-level structure that is not a "board". In the present case Korsunsky's edge-mounted electrical connector 10 cannot "place the claimed embodiments in possession of the public as fully as if the art or instrument itself had been practically and publicly employed". (Brown, supra). Applicant respectfully asserts that to construe a "edge-mounted electrical connector 10" as taught by Korsunsky is repugnant to ordinary and plain usage of the term "board". Within the scope of the disclosure, which is Applicant's claimed scope, Korsunsky fails to enable or anticipate the rejected claims.

Further as to independent claims 23 and 26, Korsunsky fails to teach any functionality "for maintaining said top surface of said extension board relatively coplanar with said top surface of said printed circuit board" (claim 23, e.g.). Consequently, claims 1-9 and 23-28 are not anticipated by Korsunsky.

The Office Action insists that a structure difference must be present. Applicant has demonstrated Korsunsky and what is claimed represent a structural difference since Korsunsky does not and cannot teach top and bottom surfaces of a board that includes a key. Withdrawal of the rejections is respectfully requested.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney, John Greaves, at (801) 278-9171, or Applicant's below-named representative to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By their Representatives,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 17th day of February 2004.

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